

REMARKS

STATUS OF CLAIMS

Claims 12-27 are now pending in this application, with claims 12, 13, 24, 26, and 27 being independent. In response to the Office Action dated July 24, 2009, claims 12,-27 have been amended to even more clearly define the invention in accordance with exemplary FIGS. 3 and 6 without changing the scope of the claims or adding any prohibited new matter.

AMENDMENT ENTRY AND IMPROPER ACTION FINALITY

It is noted that the previous Office Action of January 9, 2009, admitted (at the middle of page 4 as to independent system claim 12, at the middle of page 6 as to independent apparatus claim 13, and at the top of page 13 as to independent apparatus claim 24) that Fertilsch fails to disclose “an adding unit which adds an image processing command to image data.” The present outstanding Action changes the thrust of the outstanding rejection of claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Fertilsch (U.S. Patent Application Publication No. 2004/0061890) in view of Nakamura (U.S. Patent No. 5,970,219) by changing this admission that Fertilsch fails to disclose “an adding unit which adds an image processing command to image data” to an improper assertion that Fertilsch discloses “an adding unit which adds an image processing command to image data” based on a completely spurious interpretation of paragraph [0064] being improperly intermixed with the disclosure of paragraph [0029], all as more fully discussed below.

It is well established that there is a new ground of rejection when the basic thrust of the rejection is changed such that an applicant is in effect denied a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Note also *In re Arkley*, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972) that establishes that changing reliance on reference teachings being used in a prior art based rejection also deprives an Applicant of a fair opportunity to respond to such new reliance on such previously un-relied upon disclosures.

Not only did the previous office Action state that there was no Fertilsch disclosure being relied upon to teach the claimed “an adding unit which adds an image processing command to image data,” the present outstanding Action changes this admission to an assertion that previously un-relied upon disclosures at paragraph [0064] taken with those at paragraph [0029] somehow teach this claimed adding unit and its function but not the claimed location of this adding unit. This is but one in a steady line of shifting reliances that has been presented in the various Office Actions. Note, for example, the claimed “judging unit” that is now alleged to correspond to the print processor 69 instead of print processor 49, and the claimed “storage unit” that is now alleged to be memory 16 instead of mass storage device 26 as asserted the Action of August 8, 2008.

Clearly, making the present Action final has violated the above-noted *Kronig* and *Arkley* decisions by in effect denying Applicant a fair opportunity to react to the rejection (*Kronig*) and by denying the Applicant a fair opportunity to respond to this new reliance on previously un-relied upon Fertilsch disclosures (*Arkley*).

Accordingly, the improper finality of the outstanding Action should be withdrawn along with the entry of the present amendment.

SUMMARY OF OFFICE ACTION

The outstanding Office Action is an improper final rejection, as noted above, that again acknowledges the claim for foreign priority and the receipt of the priority document. The outstanding Office Action also again acknowledges consideration of the references cited by the IDS filed on October 13, 2005. The outstanding Office Action also again notes the Examiner’s acceptance of the drawings filed on October 13, 2005.

In addition, the outstanding Office Action includes a rejection of claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Fertilsch (U.S. Patent Application Publication No. 2004/0061890) in view of Nakamura (U.S. Patent No. 5,970,219).

REJECTION OF CLAIMS 12-27 UNDER 35 U.S.C. § 103

Item 1 on page 2 of the outstanding Action set forth the above-noted rejection of claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Fertilsch in view of Nakamura. This rejection is again traversed.

As noted in the previous response, Fertilsch at best discloses technology for effectively selecting an appropriate printer from plural printers having many kinds of different print capabilities, when performing a print job designated from a client terminal. This disclosure is substantially different from the image processing system disclosed and claimed in the present application.

Thus, the assertions in the outstanding Action that Fertilsch somehow teaches all the limitations (as listed at pages 2-4 of the outstanding Action) of exemplary independent apparatus claim 12 except for “exactly where in the system is [sic] the adding unit is located” (as noted at pages 5 of the outstanding Action) is either based on a continuing misunderstanding or misinterpretation of Fertilsch and the subject matter being claimed as evidenced by the progression of modified positions as to interpreting the teachings of Fertilsch in the various Actions in this application, or to the extent that the subject matter taught by Fertilsch has been understood, it has been inappropriately extended beyond reasonable limits to try to meet the claim limitations. These limitations include not only those as to adding unit, but also those as to the claimed “storage unit” and “judging unit,” as well as the functions claimed to be performed relative to each of these units. It is noted that similar improperly interpreted limitations appear in independent apparatus claims 13 and 24, and that the subject matter of independent method claims 26 and 27 is also similar and also improperly treated as to the outstanding Action.

First in this regard, and with reference to the previous language of exemplary independent system claim 12, it is respectfully submitted that the outstanding Action is clearly in error in suggesting that Fertilsch somehow teaches the previously claimed “adding unit which adds an image processing command to image data” based upon the allegation that paragraph [0064] somehow suggests combining image commands or sequences and/or is in any way related to paragraph [0029], lines 1-6.

For example, and as noted below, paragraph [0064] of Fertilsch only discloses that a print job can be converted into print data such as PDL. However, there exists no file format (Enhanced Meta File ('EMF') or a Printer Meta File ('PMF')) format) when this PDL conversion is used as also more fully discussed below. Also, there is no description in paragraph [0029] of Fertilsch that one or more capabilities available in the printing system are determined according to some configurations.

Turning to the particulars of paragraphs [0064] and [0029] of Fertilsch, the only teachings found in paragraph [0064] are that "the print job may be preprocessed into printer ready data, such as with an application for rendering its output into a page description language ("PDL") (e.g., PCL, Postscript, PDF, TIFF, etc.)" **or, in a mutually exclusive implementation**, the print job may include journaled data, where the rendering instructions is deferred, such as with an Enhanced Meta File ("EMF") or a Printer Meta File ("PMF")."

On the other hand, paragraph [0029] of Fertilsch relates to a completely different topic as to matching a printing job to printer printing capabilities that requires the use of a separate print processor 49 or 69 to do the matching. See paragraph [0044] of Fertilsch. These print processors determine printer capabilities in a variety of manners as noted in paragraphs [0048]-[0054]. None of this appears to be at all relevant to the paragraph [0064] disclosure of what formats can be used as to "the print job" being "preprocessed into printer ready data, such as with an application for rendering its output into a page description language ("PDL") (e.g., PCL, Postscript, PDF, TIFF, etc.)" that can result in the step of compiling rendering instructions being "skipped partly or entirely" contrary to the alternative use of the suggested formats of "Enhanced Meta File ('EMF') or a Printer Meta File ('PMF'))" that require the deferred rendering instructions noted in this paragraph. Page 22 of the outstanding Action appears to suggest that the Examiner equates these last two mentioned formats to some unknown printer data the Examiner characterizes as "printer meta data" or "meta printer object."

The only thing clear in all of this is that if the print job is preprocessed into printer ready data, such as with an application for rendering its output into a page description language ("PDL") (e.g., PCL, Postscript, PDF, TIFF, etc.), this is done and then there is no "Enhanced Meta File ('EMF') or a Printer Meta File ('PMF'))" format being used and

vice versa. Accordingly, the outstanding Action commits error as to jumping between these alternatives in making different arguments and suggesting that there is a reasonable teaching or reasonable suggestion of the claimed “adding unit” to be found in paragraphs [0064] and [0029] of Fertilsch. As noted above, there is no such reasonable teaching or suggestion to be found in paragraphs [0064] and [0029] of Fertilsch that can be reasonably said to teach the “adding unit” of amended exemplary apparatus claim 12 that can only add an imaging processing command to the converted image data when permitted to do so by the claimed “judging unit.”

Besides this clearly erroneous allegation that paragraph [0064] somehow suggests combining image commands or sequences and/or is in any way related to paragraph [0029], lines 1-6, the reliance on “a memory 16” of Fertilsch as the component corresponding to the claim 12 “storage unit” is also without merit. This is because the “memory 16” of Fertilsch is not taught or suggested to store information indicating whether or not a file format permits (prohibits) addition of a processing command. In this regard, it is clear that there is no teaching or suggestion in Fertilsch even hinting anything as to the relationship between the permission (prohibition) of addition of an image processing command and a file format into which image data is converted.

Furthermore, the “print processor 69” that is cited now as corresponding to the claimed “judging unit” is only taught to perform a matching operation in terms of matching a capability necessary to process one or more “print jobs” with a capability available as to one of the “printers 51 and 52” as described in paragraph [0044] of Fertilsch. However, with regard to file format, there is no teaching or suggestion of any specific relationship as between this “print processor 69” and the “print jobs.” Furthermore, Fertilsch fails to teach or suggest that the “print processor 69” will in any manner “judge” whether or not information indicating that the addition of an image processing command is permitted (prohibited) is stored in the storage region interpreted now as corresponding to memory 16 of Fertilsch. The reliance on the Fertilsch print processor 69 as corresponding to the claim 12 “judging unit” is, therefore, also clearly without merit.

With further regard to the exemplary claim 12 judging unit, not only does the outstanding Action rely on the “Server 69 shown in Fig. 2” as corresponding to this unit,

the outstanding Action also erroneously relies on allegations of what has to be inherently present in memory 16 that is being interpreted to be the exemplary claim 12 “storage unit.” The first problem with such stated reliance is that Fertilsch describes element 69 to be part of the server 60 that the outstanding Action also relies upon to be the exemplary claim 12 “image receiving apparatus.”

Furthermore, it is clear that paragraph [0036] of Fertilsch belies the interpretation that memory 16 corresponds to the exemplary claim 12 storage unit because memory 16 cannot be said to inherently store the previously claimed “information regarding a file format, said information including whether said file format permits addition of the image processing command to the read image data.” As was noted in the last response and nowhere contradicted by evidence included with the present outstanding Action, memory 16 of Fertilsch is not taught or suggested to store any **“information regarding”** whether a file format permits/prohibits addition of the image processing command to the read image data. In particular, no discussion can be found in Fertilsch regarding any file format permitting/prohibiting a certain image processing command, such as rotation of an image, let alone that a memory stores information regarding whether the file format permits/prohibits addition of the image processing command to the read image data.

Furthermore, element 69 of Fertilsch does not judge whether “the file format *that the image data of the original has been converted into has said information*” in memory 16 regarding the file format permitting/prohibiting addition of the image processing command to the read image data as previously recited by exemplary claim 12. Therefore, Fertilsch does not disclose or suggest that when the claimed “judging unit” that judges that the file format that the image data of the original has been converted into has the information in the storage unit regarding the file format permitting/prohibiting addition of the image processing command to the read image data, addition ... of the image processing command to the read image data is permitted/prohibited with regard to the previous recitals of exemplary claim 12.

Also, paragraph [0067] of Fertilsch has no teaching or suggestion that is relevant to the previous recital of exemplary claim 12 requiring that “when said judging unit judges that the file format *that the image data of the original has been converted into has said information* in said storage unit *regarding the file format permitting addition*

of the image processing command to the read image data, addition by said adding unit of the image processing command to the read image data is permitted” (emphasis added).

Page 22 of the outstanding Action asserts that paragraph [0056] of Fertilsch somehow discloses a “meta printer object” with apparent regard to the disclosure here (that is repeated in relied upon paragraph [0064]) as to the mutually exclusive alternative implementation in which the print job may include “journaled data, where the rendering instructions is deferred, such as with an Enhanced Meta File (“EMF”) or a Printer Meta File (“PMF”).” The outstanding Action improperly ignores that it relies on the format being the alternative PDF or TIFF type formats throughout the rationale of the rejection specifically noted at pages 2-4 of the outstanding Action. Clearly, only one of these many alternative formats is being suggested for use at any one time and there is no merit in this rebuttal argument that would inter-mix mutually exclusive formats that are disclosed to not be inter-mixed.

The reply as to the “judging unit” and the “storage unit” at page 24 of the outstanding Action is not understood. Element 69 is clearly disclosed by Fertilsch to actually be a “print processor” that matches “capabilities needed to process one or more print jobs with capabilities available at printers 50 and 52,” as noted above and at the end of paragraph [0044]. Nothing is said here or elsewhere in Fertilsch as to any relationship of this “print processor 69” to possible preprocessing of a print job as to any format noted in paragraph [0064], with or without compiled rendering instructions.

Similarly, to whatever extent that paragraph [0067] discusses a complete spool file, paragraph [0066] notes that this is simply the output from the printer driver relative to data that is preserved on disk, or any other unspecified “computer readable medium” that could be entirely distinct from memory 16. Note, for example, the Fertilsch disclosure of mass storage devices 18 and 26 as each being a “computer readable medium” that is clearly distinct from memory 16. Thus, there is nothing stated in these paragraphs of Fertilsch that even hints that the noted storage must inherently be made into memory 16.

Finally, the paragraph bridging pages 24 and 25 of the outstanding Action appears to once again shift from asserting the use of Enhanced Meta File (“EMF”) or a Printer Meta File (“PMF”) formats back to asserting the use of the alternative page description

language ("PDL") (e.g., PCL, Postscript, PDF, TIFF, etc.) formats. However, the previous positive recitals of claim 12 can not be said to be taught by the theory that if there is no program stored in some unidentified memory that supports "these languages [formats ?]" then permission is not granted. The artisan opting to use any of the Fertilsch suggested formats would have to have had at least enough skill in the art to realize that any chosen format would have to be properly implemented. The Examiner's argument is thus based on far less than ordinary skill being exercised and is clearly without merit. *See In re Sovish*, 226 USPQ 771, 774 (Fed. Cir. 1985).

In any event and as noted above, the "adding unit" of independent exemplary claim 12 (with similar subject matter added to the other independent claims 13, 24, 26, and 27) is now specified to add "an imaging processing command to the converted image data only when permitted to do so by a judging unit," subject matter not remotely suggested by Fertilsch or Nakamura, even if the artisan had some unknown reason to combine teachings from these two essentially disparate references.

Furthermore, the exemplary claim 12 "storage unit" (with similar subject matter added to the other independent claims 13, 24, 26, and 27) as now recited must store "information regarding the plural file formats, said information including whether or not said plural file formats permit addition of the image processing command to the converted image data." This is also specific subject matter that is not taught or suggested by either Fertilsch or Nakamura.

Moreover, the exemplary claim 12 "judging unit" (with similar subject matter added to the other independent claims 13, 24, 26, and 27) must judge "whether or not the file format of the converted image data has said information in said storage unit that permits addition of the image processing command to the converted image data." This exemplary claim 12 requirement is also not taught or suggested by either Fertilsch or Nakamura. Similarly, the presently specified requirement that this "judging unit permits addition by said adding unit of the image processing command to the converted image data only when said judging unit judges that said information in said storage unit permits addition of the image processing command to the converted image data" is not taught or suggested by either Fertilsch or Nakamura.

In view of the above, amended claims 12-27 are respectfully submitted to be patentable over Fertilsch and Nakamura, and the withdrawal of the rejection of claims 12-27 under 35 U.S.C. § 103(a) as being unpatentable over Fertilsch in view of Nakamura is respectfully requested.

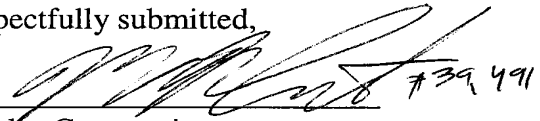
CONCLUSION

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Raymond F. Cardillo, Jr. (Reg. No. 40,440) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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